

ELECTION

Applicant elects, with traverse, what the Examiner has characterized as “Invention II”, deemed drawn to subject matter comprising passive and/or active circuit elements on a probe for automatic and/or manual tuning in an MRI field, and corresponding to claims 1-16.

REMARKS

The Examiner has identified two ‘inventions’ in the pending claims. The Examiner’s classification of the ‘inventions’ include Group I consisting of claims 17, 19-28, and 30 drawn to subject matter comprising locating the position of a device that is inside a patient’s body and classified by the Examiner in class 600, subclass 424, and Group II consisting of claims 1-16 drawn to subject matter comprising passive and/or active circuit elements on a probe for automatic and/or manual tuning in an MRI field and classified by the Examiner in class 324, subclass 322.

Applicant has added claims 31 and 32, which depend from claims 22 and 26, respectively, of Invention I to address the Examiner's assertion that the combination does not require the particulars of the subcombination. Newly presented claims 31 and 32 call for a gap configured to increase RF sensitivity away from the catheter or auto-expandable former. Accordingly, Applicant believes that Inventions I and II cannot be shown to be distinct. Further, Applicant does not believe that a tuning capacitor in a dependent claim of Invention II shows that Inventions I and II are distinct.

In addition, the Examiner must show and explain why there would be a serious burden on the Examiner if restriction is not required. MPEP 808.02 states that the Examiner must show by appropriate explanation: (A) separate classification of the inventions, (B) a separate status in the art when the inventions are classifiable together, or (C) a different field of search. The Examiner attempted to assert that restriction for examination purposes is proper “and there would be a serious search and examination burden if restriction were not required because one or more of the following reasons apply: (a) the inventions have acquired a separate status in the art in view of their different classification; (b) the inventions have acquired a separate status in the art due to their recognized divergent subject matter; (c) the inventions require a different field of search . . . ; (d) the prior art applicable to one invention would not likely be applicable to another invention; (e) the inventions are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.” *Office Action*, 03/25/08, pg. 3.

Applicant believes that the Examiner's attempt to show a serious burden if restriction is not required does not satisfy the burden required in the MPEP. That is, the MPEP requires that the Examiner show by appropriate explanation why there is a serious burden. Instead of providing an appropriate explanation, the Examiner merely presented a list of "possible" ways in which a serious burden might be shown without appropriately explaining any one of the possible ways. As such, it appears that the Examiner has merely blindly provided a list of the possible ways in an attempt to see which one may stick in the end. There has been no showing that any one in particular applies, and in fact, Applicant believes that none applies.

In particular, the Examiner has already fully examined claims 1-17, 19-28, and 30. In the Office Action mailed September 11, 2007, the Examiner rejected claims 1-17, 19-28, and 30. In response thereto, Applicant filed a response (mailed December 11, 2007) in which there were no amendments to the claims. As such, the Examiner should have already performed a proper search and examination of the claims that are now subject to restriction. Accordingly, for the Restriction Requirement (to which these remarks are in response), Applicant believes that it is not possible for the Examiner to properly show or explain that there would be a serious search and examination burden on the Examiner if restriction is not required since the Examiner has already performed such a search and examination. For there now to be a serious burden on the Examiner, such would suggest that the Examiner did not perform a full and proper search and examination of the claims in the prior Office Actions. To assert that a different field of search may be required for the above identified inventions at this point in prosecution is moot since the Examiner should have already examined such different fields of search at least in the prior Office Action because the above-identified original or previously-presented claims have been examined before.

Furthermore, Applicant believes that the addition of newly-presented claims 31 and 32 reduced the likelihood that the Examiner's list of "possible" ways in which a serious burden might be shown actually would show such a serious burden.

For all these reasons, Applicant respectfully requests rejoinder of all claims, of each group. The Examiner is invited to call the undersigned to discuss this Election or any other matters regarding this application to further prosecution.

Respectfully submitted,

/Kent L. Baker/

Kent L. Baker
Registration No. 52,584
Phone 262-268-8100 ext. 12
klb@zpspatents.com

Dated: April 24, 2008
Attorney Docket No.: GEMS8081.204

P.O. ADDRESS:

Ziolkowski Patent Solutions Group, SC
136 South Wisconsin Street
Port Washington, WI 53074
262-268-8100

General Authorization and Extension of Time

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 07-0845. Should no proper payment be enclosed herewith, as by credit card authorization being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 07-0845. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extensions under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 07-0845. Please consider this a general authorization to charge any fee that is due in this case, if not otherwise timely paid, to Deposit Account No. 07-0845.

/Timothy J. Ziolkowski/

Timothy J. Ziolkowski
Registration No. 38,368
Direct Dial 262-268-8181
tjz@zpspatents.com

Dated: April 24, 2008
Attorney Docket No.: GEMS8081.204

P.O. ADDRESS:

Ziolkowski Patent Solutions Group, SC
136 South Wisconsin Street
Port Washington, WI 53074
262-268-8100